Remarks/Arguments:

Claims 41-58, as presently amended, are pending.

Claims 59-60 are canceled, hereby, without prejudice or disclaimer.

Claim 48 is rewritten, hereby, as an independent claim. Claims 41 and 48 are rewritten by expressly reciting that the claimed serine protease inhibitor is "purified, synthesized, or genetically engineered" (*see* page 4, 4th complete ¶, and page 6, 1st ¶, of the subject application). Claims 49, 50, 54, and 55, are amended, hereby, to be dependent on claim 48, which renders claims 49-58 dependent (directly or indirectly) on claim 48.

According to the Office Action (pages 6-7), claim 48 would be allowable if rewritten in independent form. Since claim 48 is rewritten as an independent claim, hereby, claim 48 (as amended) is allowable.

As indicated above, pending elected claims 49-52 are dependent on independent claim 48. Since claim 48 is allowable, claims 49-52 are also allowable. If an independent claim is patentable, then any claim depending therefrom is patentable. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Note is taken that action on non-elected claims 53-58, is not specified in the Office Action and, also, that claims 53-58 are dependent on one of allowable claims 48-52, in view of the instant amendment. Applicants submit that, while the restriction was not traversed, it would not be improper – under §121 – to find unity of invention between the subject matter of the elected claims (as amended) and the subject matter of the non-elected claims (as amended); that is, in view of the

instant amendment, which renders all the non-elected claims dependent on the elected claims. If an independent claim is patentable, then any claim depending therefrom is patentable. *Fine, supra.*

The objection to the Oath/Declaration mistakenly states that the declaration of record "does not identify the mailing address of each invention." Contrary to the foregoing statement in the Office Action, a mailing address of each inventor is set forth in the declaration of record (filed June 23, 2000).

Claims 41-48 and 50-52 were rejected under 35 USC 101 for allegedly claiming non-statutory subject matter, i.e., subject matter found in nature. Reconsideration is requested in view of the instant amendment.

As presently amended, the claims read on a "purified, synthesized or genetically engineered" serine protease inhibitor. Since the claims are expressly limited so as not to read on a substance found in nature, the rejection under §101 is overcome and withdrawal of the rejection appears to be in order.

Claim 51 was rejected under 35 USC 112, second paragraph. Reconsideration is requested. As an initial matter, the rejection under §112, second paragraph, is based on an alleged lack of support in the originally filed application, which has nothing to do with satisfying the requirements of §112, paragraph two.

Nevertheless, the statement of rejection is incorrect. Support for the subject matter of claim 51 is, in fact, found in the application as originally filed, i.e., in original claim 11. Accordingly, withdrawal of the rejection appears to be in order.

Claims 41-47 and 49-52 were rejected under 35 USC 102(e) or 35 USC 102(e)/103(a) based on US patent application publication 2003/0055236 (Moore). Reconsideration is requested.

First of all, with respect to all of the rejected claims, the rejections under both §102(e) and §103(a) are improper. The rejections are improper because Moore does not have a 102(e) date before the filing date of the subject application.

The effective date of Moore as a reference under §102(e) is June 17, 1999, the filing date of its parent application no. 09/334,595. Although Moore claims priority to an international application filed December 17, 1998, the filing date of the international application cannot be the 102(e) date of Moore because it was not "on or after November 29, 2000." MPEP 2136. As required in MPEP 2136.03(II)(C)(3) (*emphasis added*):

> For U.S. application publications of applications that claim the benefit under 35 U.S.C. 120 or 365(c) of an *international application filed prior to November 29, 2000*, apply *the reference under 35 U.S.C. 102(e) as of the actual filing date of the later-filed U.S. application that claimed the benefit of the international application.*

Since Moore claims benefit of priority to "an international application filed prior to November 29, 2000," the examiner must "apply the reference under 35 U.S.C. 102(e) as of the actual filing date of the later-filed U.S. application that claimed the benefit of the international application," i.e., June 17, 1999 – the filing date of application no. 09/334,595.

Moreover, none of the filing dates of the US provisional applications to which More claims priority can be used, because

> international applications which . . . were filed prior to November 29, 2000 . . . may not be used to reach back (bridge) to an earlier filing date through a priority or benefit claim for prior art purposes under 35 U.S.C. 102(e).

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On the other hand, the U.S. filing date of the subject is December 23, 1998 – the filing date of the international application of which the subject application is the national stage. 35 USC 363, 365. Since the §102(e) date of Moore – June 17, 1999 – is not before the filing date of the subject application, the rejections of claims 41-47 and 50-52 based on Moore cannot be maintained. As such, withdrawal of the rejections under §§ 102(e) and 103(a) appear to be in order.

Secondly, with respect to rejected claims 48-52, the claims are rendered allowable by the instant amendment, as explained above.

Favorable action is requested.

Respectfully submitted,

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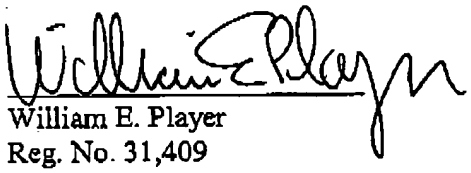
By 
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